UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/620,953	07/21/00	GRAEF	P WEYC115634

EXAMINER	
SHANEYFELT, P.	
ART UNIT	**PAPER NUMBER**
3761	2

QM12/0214

CHRISTENSEN O CONNOR JOHNSON & KINDNESS
SUITE 2800
1420 FIFTH AVENUE
SEATTLE WA 98101

DATE MAILED: 02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/620,953	GRAEF ET AL.	
	Examiner	Art Unit	
	Paul A Shanoski	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 26-27, 30, 51, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Pieniak (4,723,954).

Pieniak discloses an absorbent composite containing two strata with a transition zone intermediate and coextensive with the two strata, such that fibers from the first and second strata are comingled substantially uniformly across the width and legnth of the composite (Figures 2 and 5, column 3, lines 47-50, column 4, lines 23-28, and claim 1). The reference further teaches that the first stratum contains hydrophobic synthetic fibers and a binder (column 2, lines 57-60 and column 3, lines 5-6, as well as claim 1), and the second stratum contains hydrophilic cellulosic fibers (column 3, lines 18-19 and claim 1), and that the article is either a diaper or a sanitary napkin (claims 3-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-4, 6-10, 28-29, 31-35, 52, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak as applied to claims 1-2, 5, 26-27, 30, 51, and 53 above, and further in view of Payne et al. (5,348,547).

.Pieniak teaches the structure substantially as claimed, but fails to set forth an article having a topsheet, bicomponent fibers, as well as crosslinked cellulosic fibers. Payne teaches that it is old and well known in the art to provide absorbent articles with a topsheet (column 5, lines 7-9), and to use crosslinked cellulosic fibers in an absorbent web (column 19, line 4), and to implement bicomponent fibers as a binder (column 10, lines 57-58). One of ordinary skill in the art is determined to be one of ordinary skill in the art of absorbent articles. One of ordinary skill in the art would have been motivated to implement the topsheet and crosslinked cellulosic and bicomponent fibers of Payne into the structure of Pieniak, so as to arrive at a structure which would more readily accept and store fluid insults, and in doing so, would arrive at the claimed invention.

Claims 11-24, 36-49, and 57-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak and Payne as applied to claims 1-10, 26-35, and 51-56 above, and further in view of Matthews et al. (6,152,904).

Pieniak and Payne fail to set forth a multi-layered structure having a storage stratum and an intermediate stratum. Matthews teaches a diaper having a surge layer, a retention portion, and a distribution stratum (claim 1 and column 13, lines 48-52). One of ordinary skill in the art is determined to be one of ordinary skill in the art of absorbent articles. One of ordinary skill in the art would have been motivated to place the topsheet and crosslinked cellulosic fibers and bicomponent of Payne into the structure of Pieniak, in conjunction with the multi-layered fluid-handling structure of Matthews, so as to arrive at a structure which would more readily accept and store fluid insults, and in doing so, would arrive at the claimed invention.

Claims 25, 50 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak, Payne, and Matthews as applied to claims 1-24, 26-49, and 51-66 above, and further in view of Ahr (H1724).

Pieniak, Payne, and Matthews fail to teach the use of eucalyptus fibers. Ahr teaches an absorbent article having a topsheet and a backsheet, with an absorbent core between the two (Fig. 1 and column 3, lines 4-6), crosslinked cellulosic fibers (column 3, lines 47-48), binder fibers (column 4, line 2), and eucalyptus fibers as the preferred type of cellulosic fibers (column 4, lines 10-13). One of ordinary skill in the art is determined to be one of ordinary skill in the art of absorbent articles. One of ordinary skill in the relevant art would have known that eucalyptus fibers are a type of cellulosic

fibers, and he/she would have recognized that these are commonly used in absorbent articles. One of ordinary skill in the art would have been motivated to place the topsheet and crosslinked cellulosic and bicomponent fibers of Payne into the structure of Pieniak, in conjunction with the multi-layered fluid-handling structure of Matthews, so as to arrive at a structure which would more readily accept and store fluid insults, he/she would have known that eucalyptus fibers are a type of cellulosic fibers which are used in absorbent articles and hence he/she would have been motivated to use these types of fibers. In doing so, h/she would arrive at the claimed invention.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 26-29, 31, 36, 41, and 45 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 30, and 32-34 of copending Application No. 09/137,503 and claims 1, 11, 17, 33, 35, 37, 40, and 46 of copending Application 09/642,262. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-25 and 30-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-29, 31, and 35-77 of copending Application No. 09/137,503; claims 1-67 of copending Application No. 09/620,953; claims 1-32 of copending Application No.09/620,947; claims 1-46 of copending Application No.09/624,263; claims 2-10, 12-16, 18-32, 34, 36, 38-39, and 41-45 of copending Application No.09/624, 262; claims 1-67 of copending Application No.09/620,950; claims 1-67 of copending Application No.09/621,167, and; claims 1-46 of copending Application No.09/624,081. Although the conflicting claims are not identical, they are not patentably distinct from each other because each deals with a composite having commingled fibers which create a transitional zone which extends along the length and width of the composite.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tanzer et al. (5,433,715) (synthetic and bicomponent fibers); DiStefano (4,859,527) (wet strength agent as a binder); (Osterdahl et al. (6,080,909) (structure); Koczab (4,826,498, 5,556,392, and 5,879,344) (structure), and; Baer et al. (5,728,081) (structure).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Shanoski whose telephone number is (703) 305-0560. The examiner can normally be reached on M-F, 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for unofficial communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Shanoski
February 5, 2001

Aaron J. Lewis
Primary Examiner